

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	
Inventor: John S. Erickson et al.	: Confirmation No. 6750
	:
U.S. Patent Application No. 09/941,606	: Group Art Unit: 2162
	:
Filed: August 30, 2001	: Examiner: Anh Ly
	:
For: SOFTWARE MEDIA CONTAINER	

Attn: BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' SECOND REPLY BRIEF (37 C.F.R. 1.192)

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant submits this Second Reply Brief in response to the Examiner's Answer mailed September 17, 2007.

To the extent necessary, Appellant hereby requests any required extension of time under 37 C.F.R. §1.136 and hereby authorizes the Commissioner to charge any required fees not otherwise provided for to Deposit Account No. 08-2025.

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I. Status of Claims

No claims are allowed.

Claim 1 is rejected under 35 U.S.C. 112 as being indefinite.

Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No.: US 2001/0042043 of *Shear et al.* (hereinafter *Shear*).

II. Grounds of Rejection to be Reviewed on Appeal

- I. The rejection of claim 1 under 35 U.S.C. 112 as being indefinite.
- II. The rejection of claims 1-11 under 35 U.S.C. 102(e) as being anticipated by

Shear.

III. Argument

Appellants submit the following reply to the Second Examiner's Answer mailed on September 17, 2007 which incorporates additional arguments and remarks as well as incorporating the previously submitted arguments and remarks of Applicants' Reply Brief submitted on October 20, 2006 for completeness.

I. Claim 1 is not indefinite.

The Examiner's Second Answer mailed September 17, 2007 still does not specify under which paragraph of §112 claim 1 is rejected. For the purposes of this Second Reply Brief, Appellants assume that the Examiner intends to rely on the second paragraph of §112.

The rejection of claim 1 under 35 U.S.C. 112, second paragraph, as being indefinite due to the use of the term "and/or" is hereby traversed. Compliance with 35 U.S.C. 112, second paragraph, involves a determination of whether the claim apprises one of ordinary skill in the art of the claim scope, i.e., whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. In the present claim, the secure electronic media container is positively recited as having electronic media content stored therein and data representative of the media handler and/or a rights management mechanism required to open and play the content external of but attached to or otherwise associated with the container. The Examiner has again failed to identify specifically the lack of definiteness and/or suggest acceptable alternative language. For at least this reason, withdrawal of the rejection is respectfully requested.

Further, in the interests of compact prosecution the PTO should have raised this issue during prosecution prior to proceeding to Appeal. At no point prior to the Examiner's Answer has the PTO identified any issue of indefiniteness with respect to the language of claim 1. The fact that the PTO has been able to examine the claim language, without any indication of difficulty in understanding of claim scope, throughout prosecution to this point is evidence of the definiteness of the language. For at least this additional reason, withdrawal of the rejection is respectfully requested.

Further, the Examiner's reference to MPEP §2173.05(d) is not understood as the referenced section discusses the use of "Exemplary Claim Language ('for example,' 'such as')" which is not found in claim 1 and fails to address alternative language. It is noted that under MPEP §2173.05(h) Alternative Limitations, similar alternative language using the term "optionally" has not been necessarily considered indefinite. The MPEP sets forth that where there is no ambiguity as to which alternatives are covered by the claim, the language should be upheld. The use of "and/or" in the present claim is similar to the use of "optionally" as set forth in the MPEP. For at least this additional reason, withdrawal of the rejection is respectfully requested.

Further still, Appellants believe that the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art and note that this is the first time the Examiner has raised this particular rejection notwithstanding the fact that the claims have retained the particular language since the date of filing of the present application.

Based on the foregoing, the rejection should be withdrawn by the Examiner and, failing that, the rejection should be reversed.

II. *Shear* Fails To Anticipate Claims 1-11

1. *Shear* Does Not Anticipate Claim 1.

At the outset, Appellants submit the following remarks and arguments in response to the Second Reply Brief and point out that the Examiner has failed to rebut any of the arguments set forth in Appellants' Appeal Brief with respect to the previously-cited portions of *Shear*, i.e., Abstract and paragraphs 31, 41, and 51. For at least this reason, the rejection should be reversed.

Further, the Examiner again refers to paragraphs 283-284 and FIG. 7 of *Shear* as disclosing "a electronic media content including an external reference to video title content." Examiner's Answer at page 9, lines 16-17. However, the external reference does not appear to be external of the container as required by claim 1. As recited by the Examiner, the electronic media content includes an external reference which appears to mean that the reference is within

the content, which is inapposite to the claim limitation. For at least this reason, the rejection should be reversed.

Further still, the Examiner additionally refers to paragraphs 62 and 67-69 of *Shear* as disclosing “controlling/accessing the content of electronic media content . . . based on the requirements or by incorporating rights management protection.” Examiner’s Answer at page 9, lines 18-20. However, each of the referenced paragraphs describes the data representative of the media handler or rights management mechanism required to open and play the content as being part of the secure electronic media container and not data external of the container. For example, paragraph 62 recites “Bob’s DVD recorder detects the control codes embedded in the analog signal.” Paragraph 67 reveals that the film is played “on an DVD device incorporating rights management protection in accordance with the present invention, that opens the DigiBox secure container, accesses the control information, and decrypts the film.” Thus, paragraph 67 fails to disclose data external of the container representative of the media handler required to open and play the content because the user has already placed the DVD into an appropriate media handler. Similar to paragraph 62, paragraph 68 recites that control information “may be encoded in the analog output.” Thus, the data is not external of the container. Paragraph 69 fails to provide further disclosure beyond that provided in paragraphs 62, and 67-68. For at least this reason, reversal of the rejection is requested.

2. *Shear* Does Not Anticipate Claim 5

The Examiner’s response at page 10, fails to rebut any of the arguments set forth in Appellants’ Appeal Brief with respect to the previously-cited portions of *Shear* and fails to advance more relevant arguments in the Answer. For at least this reason, the rejection should be reversed.

3. *Shear* Does Not Anticipate Claims 2, 8, 10, and 11

The Examiner’s response at page 10, line 20 - page 11, line 2 fails to rebut any of the arguments set forth in Appellants’ Appeal Brief or prior Reply Brief of October 20, 2006. Further, the inapplicability of paragraph 69 has been addressed above. Paragraphs 74 and 78-80 of *Shear* fail to disclose at least determining the media handler required to access and handle

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the contents based on read external data. Nor do the referred-to portions of *Shear* disclose retrieving or otherwise accessing the determined media handler, and passing the content through the media handler. Rather, the Examiner-identified portions of *Shear* relate to rights management capabilities instead of media handling. For at least this reason, the rejection should be reversed.

Further, paragraphs 107, 132, and 180-181 of *Shear* relate to rights management capabilities rather than reading external data to determine a media handler to be used and passing the content through the media handler as claimed. For at least this additional reason, the rejection is requested to be reversed.

IV. Conclusion

Based on the foregoing arguments, reversal of the rejections is in order.

Respectfully submitted,

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Date: November 19, 2007

RAN/bjs